

REMARKS

Claims 30-55 and 59 presently appear in this case. Claims 30-35, 37-39 and 59 have been allowed. Claims 50-55 have been withdrawn from consideration. The remaining claims have been rejected. The official action of May 19, 2008, has now been carefully studied. Reconsideration and allowance are hereby respectfully urged.

Briefly, the present invention relates to novel sphingolipid-polyalkamine conjugates, a process for their preparation, and pharmaceutical compositions comprising the same. It also relates to the use of ceramide based polyalkamine conjugates as a capturing agent.

The examiner has required restriction among the following groups of invention:

Group 1, including claims 30-49 and 59, drawn to a compound of formula I and the process of making the same;

Group 2, including claims 50-53, drawn to a composition of the compound of formula I; and

Group 3, including claims 54 and 55, drawn to a method of capturing a molecule.

The examiner states that these groups are independent and distinct because Group 1 is directed to a compound of formula I and the process of making the same, Group 2 is directed to a composition, while Group 3 is a method of capturing a

molecule. This restriction requirement is respectfully traversed.

As to Groups 1 and 2, the compositions of claim 50 use exactly the same compounds as are claimed in claim 30. Applicant concedes that if the compound of claim 30 is unpatentable because of prior art, then claim 50 will fall with it. Restrictions should never be required when two patents would be issued with claims that would be obvious over one another. Certainly the composition of claim 50 would be obvious from the compound of claim 30 if the compound of claim 30 were in the prior art. Furthermore, regardless of classification, the search would have to be the same. There would be no further burden on the examiner in examining all of the claims. As claim 30 has been indicated to be allowable, then claim 50 must be allowable for the same reasons.

Furthermore, the present application is a 371 of an international application. Accordingly, restriction under 35 U.S.C. 121, is inapplicable. Unity of invention rules apply. Group 1 and Group 2 certainly share the same general inventive concept. The special technical feature is the compound of claim 30. This is a technical feature that defines the contribution that the claimed invention considered as a whole makes over the prior art (see MPEP 1893.03(b)).

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For all of these reasons, reconsideration and withdrawal of the restriction requirement between Groups 1 and 2, are respectfully urged.

With respect to Group 3, this is directed to a method for use of the compounds of claim 1. Again, they share the same general inventive concept and the special technical feature is the compound that is used in the use claims. As the process is "specially adapted" for the use of the compound of claim 30, restriction is inappropriate. Furthermore, Group 3 should be rejoined to Group 1 in view of the allowance of claim 30. If the compound of claim 30 is allowable, then the process of use of this compound must also be allowable. For all of these reasons, reconsideration and withdrawal of the restriction requirement insofar as Groups 1 and 3 are concerned are also respectfully urged.

Reconsideration and withdrawal of the entire restriction requirement and examination and allowance of all of the claims now present in the case are therefore respectfully urged.

Claims 36, 40 and 41-49 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The examiner states that claim 36 is indefinite because it recites "new compound".

Claim 36 has now been amended to delete the "new", thus obviating this part of the rejection.

Claims 40 and 49 have been rejected because the claims recite figures that are not in the claims.

Claims 40 and 49 have now been amended to insert these figures, thus obviating this part of the rejection.

Claims 41-49 have been rejected as indefinite because the claims recite "activating agent" and the metes and bounds of the claims are unclear. This part of the rejection is respectfully traversed.

First of all, it is not understood why claim 44 is included in this rejection as claim 44 specifies preferred examples of the activating agent. As for the remaining rejected claims, those of ordinary skill in the art would understand what the term activating agent means and would understand the metes and bounds thereof. The present specification states at page 12:

Activating groups are also known to those versed in the art, and non-limiting examples thereof include N,N'-disuccinimidylcarbonate, di- or tri-phosgene or an imidazole derivative. Other activating agents may be found in the literature [e.g. in Greg T. Hermanson *Bioconjugate Techniques*, Academic Press 1996 pp 142, 183]

Patent applications are supposed to begin at the level of knowledge of the art and explain what is new. Applicant did

not invent anything new with respect to activating groups. As this is a term well known in the art, it should be permitted in the claims.

Attached hereto are pages from Hermanson, *Bioconjugate Techniques* (1996), cited in the specification. Note particularly page 154, relating to hydroxyl-reactive chemical reactions, that states:

Hydroxyl-reactive chemical reactions include not only those modification agents able directly to form a stable linkage with an -OH group, but also a broad range of reagents that are designed to temporarily activate the group for coupling with a secondary functional group. [emphasis added]

Also attached are pages 142, 155 and 183-185 of the same reference, including some non-limiting examples of suitable activating agents.

As those of ordinary skill in the art are well aware of the meaning of "activating agent," this term should be permitted in the claims. This is not an appropriate reason to narrow the scope of claims to which applicant is entitled for the novel method of claim 41, particularly when the invention does not relate to the activating agent, *per se*. Reconsideration and withdrawal of this part of the rejection is therefore also respectfully urged.

It is noted that claims 30-35 and 37-39 have been indicated to be allowable over the prior art of record.

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Applicant wishes to make of record the substance of the examiner initiated telephone interview conducted on May 12, 2008. The examiner suggested amendments to the claims to place them in condition for allowance. Applicant requested a written office action.

It is submitted that all of the claims now present in the case clearly define over the references of record and fully comply with 35 U.S.C. 112. Reconsideration and allowance are therefore earnestly solicited.

Respectfully submitted,

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